

#20/Reg & Reinst
3/9/03
Surber
Docket No. 740819-450
Serial No. 09/708,085
Page 1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:)
Nobuhiro JIWARI et al.) Group Art Unit: 2813
Serial No. 09/708,085) Examiner: Thanh T. Nguysen
Filed: November 8, 2000)
For: METHOD FOR FABRICATING) Date: March 31, 2003
SEMICONDUCTOR DEVICE)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on March 31, 2003.


Jeannie Saxton

Request for Reconsideration

Commissioner for Patents
Washington, D.C. 20231

Sir:

The Official Action dated December 30, 2002 has been received and its contents carefully noted. In view thereof, filed concurrently herewith is a Verified English Translation of Applicants' Japanese Priority Application No. 11-319087 which perfects Applicants' claim to priority in such previously filed application having a filing date of November 10, 1999. Accordingly, reconsideration of the rejection of claims 1-3, 5-7 and 9 which are presently pending in the instant application is earnest solicited in view thereof as well as the following detailed comments.

With reference to the Official Action, claims 1-3, 5-7 and 9 have been rejected under 35

RECEIVED
APR - 7 2003
TECHNOLOGY CENTER 2800

U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,468,603 issued to Endo et al. in view of U.S. Patent No. 5,420,075 issued to Homma et al. This rejection is respectfully traversed in that the patent to Endo et al. fails to qualify as prior art with respect to Applicants' claimed invention.

Specifically, U.S. Patent No. 6,468,603 issued to Endo et al. issued on October 22, 2002 from U.S. Patent Application No. 09/663,715 filed September 18, 2000, subsequent to Applicants' effective filing date. It is noted that MPEP §1896 permits a patent applicant to rely upon the international filing date of a parent international application, under 35 U.S.C. §120, during the examination of Applicants' U.S. Patent Application, however, once the patent application issues as a U.S. patent, the effective date for the purposes of prior art is the U.S. filing date under 35 U.S.C. §111(a), on which the requisite parts of the application were received. Furthermore, it is noted that the Endo et al. reference is stated as being a Continuation of Application No. PCT/JP99/05041 filed on September 16, 1999, however, it is noted that publication of such international application could only have taken place subsequent to Applicants' effective filing date of September 10, 1999. Accordingly, it is respectfully submitted that the Endo et al. reference and its teachings are not valid prior art with respect to Applicants' claimed invention.

Accordingly, with the filing of a Verified Translation of Applicants' priority document, namely Japanese Patent Application No. 11-319087, it is respectfully submitted that Applicants' claimed invention as set forth in claims 1-3, 5-7 and 9 clearly distinguishes over the remaining teachings of Homma et al. and are in proper condition for allowance.

Should the Examiner believe a conference would be of benefit in expediting the

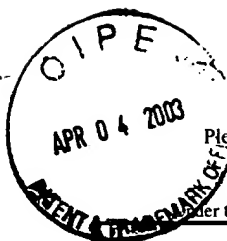
prosecution of the instant application, he is hereby invited to telephone counsel to arrange such a conference.

Respectfully submitted,



Donald R. Studebaker
Reg. No. 32,815

Nixon Peabody LLP
8180 Greensboro Drive, Suite 800
McLean, Virginia 22102
(703) 770-9300



2813

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/708,085	
	Filing Date	November 8, 2000	
	First Named Inventor	Nobuhiro JIWARI et al.	
	Group Art Unit	2813	
	Examiner Name	Thanh T. Nguysen	
Total Number of Pages in This Submission		Attorney Docket Number	740819-450

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Application Data Sheet <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Verified English Translation of Priority Document
Remarks	<input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 182380 for the above identified docket number.	

RECEIVED
APR - 7 2003
TECHNOLOGY CENTER

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	<u>Donald R. Studebaker, Reg. No. 32,815</u> Nixon Peabody LLP 8180 Greensboro Drive Suite 800 McLean, VA 22102
Signature	
Date	March 31, 2003

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: <u>3-31-03</u>			
Type or printed name	Jeannie Saxton		
Signature		Date	March 31, 2003

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.